

## REMARKS

Applicant wishes to thank the Examiner for the detailed remarks and the allowance of claims 12, 15, and 17. Claim 13 has been amended to include the allowable limitations of allowable claim 20.

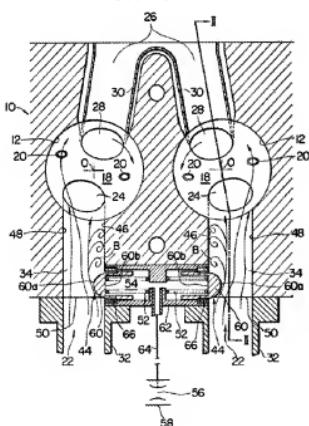
Claims 6 and 7 were rejected under 35 U.S.C. §102(b) as being anticipated by *Miyazaki* (4180041). Applicant respectfully traverses this rejection as claim 6 has been amended to include the limitations of claim 7 and claim 7 has been cancelled.

Claims 1-5, 7-11, 13, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyazaki* as applied to claim 6 above, and further in view of JP '613. Applicant respectfully traverses these rejections as there is absolutely no teaching, suggestion, or motivation to modify *Miyazaki* in view of JP '613. The Examiner states:

*Miyazaki* applies as noted above and JP('613) teaches the locating the expandable member in the intake plenum with a spring-like bellows between the member and the plenum. Note that locating a spring within the enclosure as opposed to being part of the enclosure, has already been taught by *Miyazaki*

[10/10/2006 Office Action, p. 2.] Applicant is unclear regarding the Examiner's argument, however, *Miyazaki* simply fails to disclose or suggest a deformable member within a *plenum*.

*FIG. 1*



Notably, the flow restrictor means 44c takes the form of a plunger 96 having a half spherical head 96a protruding into the intake port passage 34. [Col. 5, lines 34-48.] The bellows 90 is located completely within the engine block 10 adjacent to intake passageways 22 under control of an intake valve 24. As such, *Miyazaki* does not locate a deformable member within a plenum. That is, the deformable member, at best, is located completely within the engine block and only the flow restrictor means selectively enter intake passageways 22.

Furthermore, the intake passageways 22 may not even properly be considered a plenum as recited by Applicant. Intake passageways 22 are most appropriately equivalent to runner passageways 18 as discussed by Applicant. That is, *Miyazaki* is located in a completely different location than Applicant's claimed deformable member.

It is axiomatic that an obviousness rejection must come from the suggestion or teachings of the references themselves. A proper suggestion or motivation to make a combination requires some benefit to result from the combination. When the additional teachings of a secondary reference do not provide any benefit to the arrangement disclosed in a primary reference, no *prima facie* case of obviousness exists. JP '613 illustrates an intake manifold with bellows and changing the volume of the internal space of the intake manifold depending upon the number of engine revolutions. [English abstract.] There is simply no benefit to relocate the flow restrictor means of *Miyazaki* to any other location. This is especially so considering that the flow restrictor means 44 of *Miyazaki* interacts with a multiple of intake passageways 22. Because the combination provides no benefit, and is therefore improper, there is no *prima facie* case of obviousness.

It should also be noted that:

An abstract and the underlying document of which it is a summary are distinct documents. In a rejection, an abstract stands on its own—it does not incorporate by reference any disclosure of the underlying document. Abstracts are often not written by the author of the underlying document, and may be erroneous or misleading—in virtually all cases, they are incomplete.

Generally an abstract does not provide enough information to permit an objective evaluation of the validity of what it describes. Thus, an abstract is even less reliable a basis to extrapolate the alleged teachings of the underlying document to different circumstances. Abstracts function to alert a reader to

disclosures of possible interest. They are little more reliable than headlines or brief newspaper articles.

Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. It is our opinion that a proper examination under 37 CFR Section 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.

See *Ex parte Gavin*, 62 U.S.P.Q.2D (BNA) 1680

Without a translation, the exceedingly minimal abstract of JP '613 fails to be a reliable basis to extrapolate the alleged teachings argued by the Examiner. Applicant requests that the Examiner obtain a translation to substantiate the rejection or retract the rejection.

Applicant respectfully submits that this case is in condition for allowance in response to the amendments made herein.

Respectfully Submitted,  
**CARLSON, GASKEY & OLDS, P.C.**

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